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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,814	04/14/2004	Tsutomu Okada	17614	5629
23389 7590 09/10/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER PAPAPIETRO, JACQUELINE M	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,814	<b>Applicant(s)</b> OKADA, TSUTOMU	
	<b>Examiner</b> Jacqueline Papapietro	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Kokai (Publication No. 4-329944).

Kokai discloses a radio knife (1) comprising: an electrically insulating flexible sheath (2) having a distal end portion and a proximal end portion, the distal end portion of the sheath having a distal opening (13) and an axis; a support member (4) which closes the distal opening of the sheath (Fig 4), the support member having a slide hole with diameter smaller than that of the distal opening extending along the axis thereof (Fig 4); an operating wire (14) axially movable in the sheath (paragraph 0013 lines 8-14); an electrode portion (6) which has a distal end portion and a proximal end portion and of which least a part forms a rod-shaped portion (Fig 4), the proximal end portion of the electrode portion being coupled to the operating wire (paragraph 0013 lines 4-6), the rod-shaped portion being passed through the slide hole for axial projection and retraction (X, shown in Fig 5); a control section (3 and 15) which is provided on the proximal end portion of the sheath (Fig 5) and controls the operating wire to project and retract the electrode portion in the axial direction (paragraph 0013 lines 8-14), the control section having a high-frequency current supply portion (paragraph 0010 lines 6-

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8) which supplies a high-frequency current to the electrode portion (paragraph 0011 lines 9-12); a liquid feed portion which is provided on the proximal end side of the sheath and feeds liquid into the sheath (17); and an opening for liquid feed which is formed in the support member, the opening for liquid feed within the sheath being configured to introduce the liquid from the proximal end side to the distal end side of the sheath in the axial direction thereof (paragraph 0014 lines 3-5, see Fig 1).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7-9, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kokai (Publication No. 4-329944) in view of Rexroth et al (US 4943290).

Regarding claims 1 and 7, 11 and 13, Kokai discloses a radio knife (1) comprising: an electrically insulating flexible sheath (2) having a distal end portion and a proximal end portion, the distal end portion of the sheath having a distal opening (13) and an axis; a support member (4) which closes the distal opening of the sheath (Fig 4), the support member having a slide hole with diameter smaller than that of the distal opening extending along the axis thereof (Fig 4); an operating wire (14) axially movable in the sheath (paragraph 0013 lines 8-14); an electrode portion (6) which has a distal end portion and a proximal end portion and of which least a part forms a rod-shaped portion (Fig 4), the proximal end portion of the electrode portion being coupled to the

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operating wire (paragraph 0013 lines 4-6), the rod-shaped portion being passed through the slide hole for axial projection and retraction (X, shown in Fig 5); a control section (3 and 15) which is provided on the proximal end portion of the sheath (Fig 5) and controls the operating wire to project and retract the electrode portion in the axial direction (paragraph 0013 lines 8-14), the control section having a high-frequency current supply portion (paragraph 0010 lines 6-8) which supplies a high-frequency current to the electrode portion (paragraph 0011 lines 9-12); a liquid feed portion which is provided on the proximal end side of the sheath and feeds liquid into the sheath (17); and an opening for liquid feed which is formed in the support member, the opening being arranged around the slide hole (paragraph 0014 lines 3-5). Kokai also discloses the radio knife wherein the sheath has an extending portion extending ahead of the support member, the extending portion having an internal space, which stores the electrode portion (Fig 5). Kokai does not disclose that the opening is arranged independently of the slide hole. The translation of Kokai is silent regarding the electrical conductivity of the support member.

Rexroth teaches an electrosurgical device (10) comprising an electrically insulating sheath (70, column 9 lines 3-5) having a distal end portion and a proximal end portion, the distal end portion of the sheath having a distal opening and an axis (Fig 4). The insulation sheath inherently forms a support member which closes the distal opening of the sheath, and is insulating. The insulating tip defines a slide hole for the rod-shaped electrode shaft (50), the slide hole having a diameter smaller than that of the distal opening (Fig 14). The electrosurgical device of Rexroth has a liquid feed

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portion (18), and an opening (72D, Fig 12) arranged around and independently of the slide hole (see Fig 12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Kokai by arranging the opening independently of the slide hole in order to displace electrically conductive fluids from the surgical site proximate the electrode and by making the support member an electrically insulating tip in order to prevent short circuiting of the device, as taught by Rexroth.

Regarding claims 8 and 9, Kokai discloses the radio knife as described above, but does not disclose an extending portion of the rod-shaped portion extending across the extending direction of the rod-shaped portion or being hooked. Rexroth teaches a radio knife, as described, wherein the electrode portion (50) has an extending portion (26) located on the distal end portion of the rod-shaped portion and extending across the extending direction of the rod-shaped portion (Fig 15), and wherein the extending portion is a hooked bent portion (26C) extending substantially at right angles to the distal end portion of the rod-shaped portion (Fig 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Kokai by including the features taught by Rexroth, as described above, and by forming an extending portion of the rod-shaped portion as extending across the extending direction or as a hook in order to catch tissue around the extending portion.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kokai in view of Rexroth as applied to claim 8 above, and further, in view of Kittur et al (US 5846241).

Kokai in view of Rexroth does not specifically disclose a platelike electrode. Kittur teaches a radio knife (10) wherein the extending portion (22) is a platelike electrode portion (24) coupled to the distal end portion of the rod-shaped portion (20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Kokai in view of Rexroth with the platelike electrode of Kittur because all three inventions are similar electrosurgical devices that perform similar functions. It would have been obvious to combine the three inventions in order to provide one device with an increased number of applications for which it can be used.

### ***Response to Arguments***

Applicant's arguments filed June 14, 2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the width of the opening) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Although the amendments that have been made seem minor to Applicant, Examiner has found that every claim is now anticipated or obvious, as described above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline Papapietro whose telephone number is (571) 272-1546. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Art Unit 3739



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